IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Richmond Division

NTP, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	**Civil Action No. 3:07cv549JRS**
	)	
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,	)	
	)	
	)	
Defendant.	)	

VERIZON WIRELESS' MOTION TO STAY

Defendant Cellco Partnership, d/b/a Verizon Wireless ("Verizon Wireless"), by counsel, moves to stay this action pending the conclusion of all proceedings, including appeals, arising out of the United States Patent and Trademark Office's reexamination of the patents asserted against Verizon Wireless by Plaintiff NTP, Inc. ("NTP"). Senior PTO examiners have issued a series of final office actions rejecting all of the claims of each of the patents that NTP seeks to assert against Verizon Wireless in this case, and, citing the ongoing reexamination process of NTP's patents (including most of those at issue in this case), the Court has previously stayed patent claims brought by NTP against a different accused infringer. The bases for the relief requested by Verizon Wireless are set forth more fully in the accompanying memorandum and exhibits.

Dated: September 14, 2007

Respectfully submitted,

CELLCO PARTNERSHIP d/b/a VERIZON WIRELESS

By Counsel

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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Richmond Division

NTP, INC., **Plaintiff,** **v.** **CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,** **Defendant.**	**Civil Action No. 3:07cv549JRS**

MEMORANDUM IN SUPPORT OF VERIZON WIRELESS' MOTION TO STAY

Defendant Cellco Partnership d/b/a Verizon Wireless ("Verizon Wireless"), by counsel, states the following in support of its motion to stay this action pending the conclusion of all proceedings, including appeals, arising out of the United States Patent and Trademark Office's ("PTO") reexamination of the patents asserted against Verizon Wireless by Plaintiff NTP, Inc. ("NTP").

INTRODUCTION

"It would be a painful tragedy – for everyone involved – if this litigation were allowed to move forward during the PTO's reexamination, only to be rendered meaningless by that agency's final action." *NTP, Inc. v. Palm, Inc.*, Civ. Action No. 3:06CV836, slip. op. at 5 (E.D.Va. March 22, 2007) (Spencer, J.) (attached as Ex. 1). With those words, the Court stayed NTP's patent infringement lawsuit against wireless equipment manufacturer Palm, Inc. ("Palm") earlier this year. Now the Court is faced with a yet another NTP suit, this time against wireless provider Verizon Wireless. No meaningful distinction can be made between these two cases, and the consequences of allowing this suit to proceed before final resolution of the reexaminations would be equally tragic.

In fact, upon receiving the Complaint, counsel for Verizon Wireless contacted NTP's counsel in an effort to reach agreement on a stay pending completion of the current PTO proceedings. Surprisingly, notwithstanding the Court's decision in the *Palm* case, and despite NTP's acknowledgement that all of the claims of the patents-in-suit have now been held to be unpatentable at the examiner level at the PTO, NTP failed to respond to this request, thereby forcing Verizon Wireless to bring the instant motion.

To be clear, NTP has now sued Verizon Wireless for patent infringement long after three different senior examiners at the PTO have declared that NTP's patents-in-suit never should have issued. NTP's Complaint freely acknowledges that "[t]he PTO rejected all of the claims of the Patents-in-Suit." Compl. ¶ 31. Today, NTP is continuing the uphill climb of appealing to the PTO's Board of Patent Appeals and Interferences ("BPAI") from those rejections by the examiners.

As in *Palm*, NTP's claims will be moot if the BPAI affirms the examiners' rejections of NTP's claims. Each and every claim identified in NTP's complaint against Verizon Wireless has been rejected and affirmation of those rejections will end this case. Moreover, even if the rejections were somehow reversed in whole or in part on appeal, the appellate rulings will focus the issues in the case, thereby conserving judicial resources. Some patents or claims may be eliminated entirely; some claims may be narrowed; new claims may be added; and any remaining patents will have been analyzed keenly through the reexamination and appeals process. This Court would benefit from that analysis.

As in *Palm*, NTP will not be prejudiced by a stay. NTP's alleged injuries, if any, are fully compensable by money damages. *See, e.g. MercExchange LLC v. eBay Inc.*, __ F. Supp.2d __, 2007 WL 2172587, *9 (E.D. Va. Jul. 27, 2007) (citing patentee's willingness to license the infringer as evidence that money, as opposed to injunction, could have adequately compensated the patentee); *see also Paice LLC v. Toyota Motor Corp.*, 2006 WL 2385139, *5 (E.D. Tex. Aug. 16, 2006) (citing patentee's offer to license infringer as demonstrating the adequacy of monetary relief from patentee's point of view). And, in these early stages of the case – Verizon Wireless' responsive pleadings will not be due for some time yet – NTP cannot have made a substantial investment in this case that would be disrupted by a stay. Thus, this case is unlike NTP's litigation against Research in Motion, Ltd. ("RIM") where RIM moved for a stay only ***after*** an adverse jury verdict. *See NTP, Inc. v. Research In Motion, Ltd.*, 397 F. Supp. 2d 785 (E.D. Va. 2005) (Spencer, J.).

As in *Palm*, a refusal to stay the case would greatly harm the defendant. Allowing this case to proceed would expose Verizon Wireless to substantial expense — both in terms of legal fees, expert witness fees, and the resources of its management — all to defend a suit that, at present, appears to have no legal basis whatsoever. A stay is the appropriate response.

Just as it stayed NTP's suit against Palm, this Court should stay this action pending the outcome of those proceedings, including any further appeals.

FACTUAL BACKGROUND

NTP filed this suit on September 7, 2007, contending that Verizon Wireless' products and services infringe one or more claims of each of NTP's eight patents-in-suit.[1] Long before

[1] U.S. Patent No. 5,436,960 ("the '960 patent"); U.S. Patent No. 5,438,611 ("the '611 patent"); U.S. Patent No. 5,625,670 ("the '670 patent"); U.S. Patent No. 5,819,172 ("the '172 patent"); U.S. Patent No. 6,067,451 ("the '451 patent"); U.S. Patent No. 6,317,592 ("the '592

NTP sued Verizon Wireless, however, PTO examiners already had determined that the claims that NTP has asserted here are unpatentable; all of those claims have been rejected in final office actions by the PTO.

The PTO itself initiated reexamination of five of the patents-in-suit (the '670, '172, '451, '592 and '946 patents) in 2002. NTP requested reexamination of a sixth patent (the '611 patents) in 2003. Additionally, a third-party requested *ex parte* reexamination of the seventh and eighth patents (the '960 and '472 patents) in 2003. Ex. 2 (excerpts from reexamination files).

In February 2006, the PTO issued final office actions rejecting the pending claims of the '960 patent (claims 1-89, 183-193, 195-233) and the pending claims of the '451 patent (claims 1-341, 393-437). Ex. 3 (excerpts from reexamination files). The Examiners determined that these claims were anticipated and/or obvious based upon at least four pre-existing printed publications. At that time, the PTO also rejected all 764 of the pending claims in the '592 patent and issued an Office Action closing prosecution in the *inter partes* reexamination. Ex. 4 (excerpts from reexamination files). On August 22, 2006, the PTO issued final rejections of all the pending claims of the '172, '670, '611 and '472 patents. Ex. 5 (excerpts from reexamination files). Again, at least four pre-existing printed publications formed the basis for the PTO's decision that NTP was not the first to invent its patent claims. That same month, the PTO issued a final office action rejecting all the pending claims of the '946 patent (claims 1-185 and 288-333). Ex. 6 (excerpts from reexamination files). The Examiner determined that these claims were

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patent"); U.S. Patent No. 5,479,472 ("the '472 patent"); and U.S. Patent No. 5,631,946 ("the '946 patent") (collectively, the "patents-in-suit").

anticipated and/or obvious based upon at least ten pieces of prior art, and furthermore, failed to comply with the written description requirement of 35 U.S.C. § 112.[2]

In each instance, NTP has challenged the PTO's rejections in appeals to the PTO's BPAI. The following chart demonstrates the status of those appeals:

Count	Patent	Final Rejection	Appeal Brief Filed	Examiner's Answer Mailed
I	'960	02/24/06	06/26/06	09/10/07
II	'611	08/22/06	12/21/06	09/05/07
III	'670	08/22/06	12/21/06	08/30/07
IV	'172	08/22/06	12/21/06	08/30/07
V	'451	02/22/06	06/26/06	08/20/07 08/24/07
VI	'592	02/01/06	06/07/07	08/20/07 08/24/07
VII	'472	08/22/06	12/19/06	09/04/07
VIII	'946	08/22/06	12/19/06	08/30/07

Ex. 7 (excerpts from reexamination files). If those appeals fail, NTP has the right to appeal to the Court of Appeals for the Federal Circuit.

Of the eight patents-in-suit, seven were asserted against Palm, in a case now stayed in this Court. Five of the eight patents-in-suit – the '670, '172, '451, '592 and '960 patents – were fully litigated in *RIM*. Compl. ¶¶ 24-26. However, the PTO's rejections of those patents

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[2] The sheer breadth and strength of these rejections strongly supports a stay. *See Middleton, Inc. v. Minn. Mining & Mfg. Co.*, No. 4:03-CV-40493, 2004 WL 1968669 (S.D. Iowa Aug. 24, 2004) (granting stay pending reexamination and noting that "the Court is influenced by the breadth of the reexamination and the number of prior art references under active review").

(indeed, all the patents-in-suit) were based largely on prior art references that were not subject to trial on the merits in *RIM*. *See*, *e.g.*, Ex. 8 (Nov. 30, 2005, Decision Denying Petition, '592 Reexamination Proceedings), at 4.

ARGUMENT

I. A STAY SHOULD BE GRANTED PENDING FINAL RESOLUTION OF THE REEXAMINATION OF THE PATENTS IN SUIT.

The reexamination process allows any person to request that the PTO reexamine or reevaluate an unexpired U.S. patent whose patentability is "doubtful." *In re Etter*, 756 F.2d 852, 857 (Fed. Cir. 1985) (*en banc*); 35 U.S.C. §§ 301-307. The process was established to provide for the "efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." H.R. Rep. No. 96-1307 at 2-3 (1980), *reprinted in* 1980 U.S.C.C.A.N., at 6460, 6462-63 (1980).

Congress anticipated that, to facilitate this goal, courts would stay litigation pending patent reexamination. In fact, as the Federal Circuit has observed, early versions of the reexamination statute "expressly provided for a stay of court proceedings during reexamination." *Gould v. Control Laser Corp.*, 705 F.2d 1340, 1342 (Fed. Cir. 1983) (citations omitted). Congress deemed an express stay provision unnecessary, however, because a federal court has "inherent power to manage [its] dockets and stay proceedings ... including the authority to order a stay pending conclusion of a PTO reexamination." *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988). In fact, the stay of pending litigation to enable the PTO to review contested patents was one of the specified purposes of the reexamination legislation. *See Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 606 (Fed. Cir. 1985), *modified, aff'd in part, rev'd in part on other grounds on rehearing*, 771 F.2d 480 (Fed. Cir. 1985).

In ruling on motions to stay, courts consider "(1) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether discovery is complete and whether a trial date has been set." *Microstrategy Inc. v. Business Objects SA*, No. 2:01cv826, slip op. at 4 (E.D. Va. June 12, 2002) (Friedman, J) (granting stay) (Ex. 9); *see also Tap Pharm. Prods., Inc. v. Atrix Labs., Inc.*, 70 U.S.P.Q.2d 1319, 1320 (N.D. Ill. 2004); *Target Therapeutics, Inc. v. Scimed Life Sys., Inc.*, 33 U.S.P.Q.2d 2022, 2023 (N.D. Cal. 1995). The decision to stay legal proceedings pending reexamination therefore rests with the sound discretion of the court. *Gould*, 705 F.2d at 1341-42. In exercising this discretion, courts have recognized "that there is a liberal policy in favor of granting motions to stay proceedings pending the outcome of USPTO reexamination … proceedings." *ASCII Corp. v. STD Entm't USA, Inc.*, 844 F. Supp. 1378, 1381 (N.D. Cal. 1994); *Ingro v. Tyco Indus., Inc.*, 227 U.S.P.Q. 69, 71 (N.D. Ill. 1985) ("legislative history indicates Congress … approved of courts liberally granting stays within their discretion."); *see also Gould*, 705 F.2d at 1342 (affirming stay because "[w]hen a district court stays patent validity proceedings before it until completion of a reexamination proceeding, that stay must be accepted *if the purpose of the reexamination statute is to be preserved*") (emphasis added).

The Court followed precisely this path in *Palm*. First observing its natural authority to stay litigation, Ex. 1, slip. op at 4, the Court noted that, while Palm had answered the Complaint and discovery had commenced, the case was still in the early stages of discovery and no trial date had been set. *Id.* at 4-5. The Court noted the "significant benefits to staying this matter until the validity of the patents-in-suit may be established," since the reexamination process might entirely obviate the need for further litigation. *Id.* at 5. Alternatively, said the Court, if NTP were to prevail, "the parties and the Court will have the PTO's expert opinion regarding the scope and validity of the patent claims . . . and both will be in a better position to assess the issues raised in this civil action." *Id.* (citation omitted).[3] While it expressed some sympathy to NTP's argument that a stay would deny it the chance to enjoin further alleged infringement, the Court balanced that against "the fair possibility that the PTO will determine [NTP's] claims to be unenforceable," concluding that "a stay [was] necessary to avoid further and improvident expenditure of time and resources." *Id.* at 6.

A. The PTO's Rejection Of The Asserted Claims Strongly Favors A Stay.

1. The PTO's Rejection Of The Asserted Claims As Invalid Raises Powerful Practical Reasons Favoring A Stay.

Palm dictates the same result here.

First, if the rejections are upheld on appeal, this case will be subject to immediate termination. The expense and drain of this case on resources need never take place. That alone is sufficient reason to stay this litigation pending the conclusion of the reexamination procedures. "There is simply no reason to justify the maintenance and expense of this action during the pendency of an examination whose resolution could summarily resolve these matters." *Palm*, Ex. 1, slip op. at 6; *see also Ethicon,* 849 F.2d at 1426 ("One purpose of the reexamination procedure is to eliminate trial of [the patent validity] issue (when the claim is canceled) ....") *quoting*

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[3] The decisions of other courts are in harmony with the Court's decision in *Palm*. *See, e.g.*, *Methode Elecs., Inc. v. Infineon Techs. Corp.*, No. C99-21142, 2000 U.S. Dist. LEXIS 20689 (N.D. Cal. Aug. 7, 2000) (granting stay, reexamination underway before lawsuit initiated; motion to stay brought without delay); *Tap Pharm. Prods.*, 70 U.S.P.Q.2d 1319 (granting stay, requests for reexamination were granted before the instant suit was filed); *Target Therapeutics, Inc.*, 33 U.S.P.Q.2d at 2024 (granting stay, no prejudice to patentee because reexamination request had been filed months before the lawsuit); *Hewlett-Packard Co. v. Acuson Corp.*, No. C-93-0808, 1993 WL 149994 at *2 (N.D. Cal. May 5, 1993) (granting stay because "HP did not seek to enforce its patent until after Acuson had filed its Request for Reexamination").

Gould, 705 F.2d at 1342; *In re Cygnus Telecomms. Tech., LLC*, 385 F. Supp. 2d 1022, 1023 (N.D. Cal. 2005) (same); *San Giacomo N.A. v. Pilliod Furniture*, No. 2:95-CV-00739, 1996 U.S. Dist. LEXIS 14440, *3 (M.D.N.C. August 13, 1996) ("The *primary* purpose of the reexamination procedure is to eliminate trial of [the patent validity] issue (when the patent is canceled) ....") (emphasis added).

Moreover, even if any claims do survive the reexamination proceedings, they may be substantially narrowed (or completely new). Hence, if this case were to proceed, the parties would be shooting at a moving target: whatever analysis NTP or Verizon Wireless may conduct regarding the claims presently at issue may well be moot and the claims that it may actually face at trial may only come into existence after discovery has concluded (requiring reopening of the pretrial proceedings). These risks are extinguished by a stay.

2. The PTO's Rejections Raise Substantial Issues Of Comity That Militate In Favor Of A Stay.

When the PTO determines during reexamination that claims of a patent are unpatentable, basic principles of administrative law and comity argue in favor of permitting the completion of that process before further litigation proceeds in the district court, regardless of the fact that NTP has appealed the examiners' decisions to the BPAI. *See, e.g.*, *Canady v. Erbe Elektromedizin GmbH*, 271 F. Supp. 2d 64, 75 (D.D.C. 2002). In *Canady*, the district court declined to lift a stay of litigation pending reexamination. The PTO had already issued an office action rejecting certain claims as unpatentable during the first reexamination, and two additional requests for reexamination were still ongoing. "[W]here issues require technical expertise and that expertise is available through an administrative agency, the court should allow that agency to come to a final determination before rendering a decision on that issue." *Id.* at 75; *see also ASCII Corp.*, 844 F. Supp. at 1380 ("Congress enacted the [USPTO] reexamination procedure to provide an inexpensive, expedient means of determining patent validity which, if available and practical, should be deferred to by the courts.") (citing *Digital Magnetic Sys., Inc. v. Ansley*, 213 U.S.P.Q. 290 (W.D. Okla. 1982)).

B. A Stay Will Conserve Judicial Resources — Even If The Rejections Are Reversed.

Even if the examiners' rejections of the claims are reversed in part – or even entirely – the efficiencies to be gained by a stay of this litigation are substantial.

As the Court acknowledged in *Palm*, there is at least a "fair possibility" that NTP's patents will not be revived on appeal, but even if they are, they will likely be changed substantively. *See Microstrategy*, Ex. 9, slip op. at 4 (given that 70% of patents undergoing reexamination have some claims amended or cancelled, "the likelihood that there will be some changes to the claims is more probable than not.") If the rejections are partially reversed, then invalidation of even *some* of the patents would substantially narrow the case and save resources. As the court in *Teradyne* observed: "Since the reexamination process may narrow and perhaps eliminate issues concerning the patents' validity, the court should not expend unnecessary judicial resources by trying to resolve these claims now." *Teradyne, Inc. v. Hewlett-Packard* Co., No. C-91-0344, 1993 U.S. Dist. LEXIS 14601, *23 (N.D. Cal. Jan. 7, 1993).

And, as this Court noted in *Palm*, both the parties and the Court would benefit from the PTO's expert opinion on the scope and validity of any claims that actually do manage to survive the reexamination process. *Palm*, Ex. 1, slip op. at 5; *see also EchoStar Techs., Corp. v. TiVo, Inc.*, No. 5:05-CV-00081, 2006 U.S. Dist. LEXIS 48431, *4-5 (E.D. Tex. July 14, 2006) (citing *Fisher Controls Co. v. Control Components, Inc.*, 443 F. Supp. 581, 582 (S.D. Iowa 1977) (listing factors regarding the streamlining of post-stay litigation that militate in favor of a stay)); *accord Emhart Indus., Inc. v. Sankyo Seiki Mfg. Co.*, 3 U.S.P.Q.2d 1889, 1890 (N.D. Ill. 1987);

GPAC, Inc. v. D.W.W. Enters., Inc., 144 F.R.D. 60, 63 (D.N.J. 1992); *see also In re Etter*, 756 F.2d at 857 (noting that "an auxiliary function of reexamination is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration).

C. A Stay Will Not Prejudice NTP.

NTP will not be prejudiced by a stay pending reexamination. It has preserved whatever rights and remedies it may have against Verizon Wireless by filing this case. Having done that, NTP has no need for expedition. If NTP prevails both in the reexamination process and at trial, it will be fully compensated for any delays. *See, e.g., Patlex*, 758 F.2d at 603 (if patents upheld on reexamination, the patent owner can recover damages from those who have infringed his patent during reexamination); *Microstrategy*, Ex. 9, slip op. at 5 (since plaintiff's injury could be fully redressed by damages, plaintiff would not be prejudiced by a stay lasting as long as four years).[4]

In *Palm,* the Court stayed NTP's suit even though discovery had commenced, noting that the case was still in its early stages. Similarly, in *Tap Pharmaceutical Products*, the court granted defendant's motion to stay, finding that the plaintiff would not be unduly prejudiced where the discovery had yet to commence. *Tap Pharm. Prods., Inc.*, 70 U.S.P.Q.2d at 1320; *see also Target Therapeutics, Inc.*, 33 U.S.P.Q.2d at 2023 (concluding an absence of prejudice to the non-moving party because "[t]he parties have not engaged in expensive discovery and no trial date has been set."); *Microstrategy*, Ex. 9, slip op. at 8 (lack of substantive discovery and dispositive motions weighed in favor of granting stay, even though trial date was only four

[4] Note, however, that if the claims are substantially amended, NTP's right to damages for infringement would only run from the time the patent reissues after examination. *Microstrategy*, slip op. at 5. Under these circumstances, not only will a stay not prejudice NTP (since NTP would have no prior right to damages), but a stay would also ensure that any damages awarded to NTP are calculated correctly the first time.

months away); *ASCII Corp.*, 844 F. Supp. at 1381 (granting a stay pending reexamination when "the parties are in the initial stages of the lawsuit and have undertaken little or no discovery" and "the case has not been set for trial").

Here, Verizon Wireless has brought its stay request *even before it has to answer*. In these circumstances, even more so than in the other cases cited, NTP simply cannot have invested substantial time in this case.

Even if there were prejudice to NTP (and there is not), NTP is not in a position to complain. Though Verizon Wireless' accused products and services have been on the market for several years, Compl. ¶ 33-40 (identifying, with varying degrees of specificity, accused products and services), and though NTP claims to have notified Verizon Wireless about its alleged patent rights more than eight years ago, Compl. ¶ 41, NTP chose not to sue Verizon Wireless until long after patent examiners had issued final rejections of NTP's patent claims. Nothing prevented NTP from bringing suit at an earlier date. Having waited until after the rejection of the claims by the patent examiners – nearly five years after the initiation of these reexaminations, and more than a full year after every final rejection – NTP should accept the consequences of its tactical decision to file suit only at this late juncture.

Finally, awaiting the resolution of all appeals of the reexamination proceedings will not unduly delay the resolution of this litigation. By statute, "[a]ll reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch." 35 U.S.C. § 305. When the patents under reexamination are involved in litigation, they will have priority over all other cases, including other reexaminations and reissues not in litigation. Manual of Patent Examining Procedures ("MPEP") § 2261 (available at www.uspto.gov/web/offices/pac/mpep/mpep.htm). When litigation is stayed pending the outcome of the reexamination, all proceedings will be further expedited to the extent possible. MPEP § 2686.04. *See also Canady,* 271 F. Supp. 2d at 76 ("[W]here litigation is stayed pending a decision by the PTO, reexamination proceedings will be expedited to the extent possible.").

D. Failing To Stay The Case Would Prejudice Verizon Wireless.

By stark contrast, Verizon Wireless would suffer immeasurable harm if this litigation were allowed to proceed. If this case goes forward, Verizon Wireless will have to expend substantial time and resources defending itself against allegations of infringement of patent claims that the PTO has already determined are unpatentable. A stay of litigation pending resolution of all appeals of the reexamination proceedings will conserve the resources of the Court – and both parties – and is appropriate for the reasons discussed above.

The monetary costs to Verizon to defend itself in this litigation will be substantial. This year, the average estimated cost of defending a patent infringement suit in the Eastern District of Virginia (with alleged damages over $25 million) is $6.96 million. *Am. Intell. Prop. L. Ass'n,* 2007 Report of the Economic Survey, I-91 (2007) (excerpts attached as Ex. 10).[5] And, those costs are purely monetary, and fail to reflect the additional expenses and time commitments to corporate executives and engineers surrounding major patent litigation.

CONCLUSION

For the foregoing reasons, Verizon Wireless respectfully requests that the Court grant its motion to stay this litigation pending resolution of the patent reexamination proceedings, including all appeals therefrom.

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[5] The Eastern District of Virginia falls under the category of "Other East" on the chart attached as Ex. 10.

Dated: September 14, 2007

Respectfully submitted,

CELLCO PARTNERSHIP d/b/a VERIZON WIRELESS

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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
RICHMOND DIVISION

NTP, INC.,

Plaintiff,

v.

PALM, INC.,

Defendant.

Civil Action No.: 3:06–CV–836

MEMORANDUM OPINION & ORDER

THIS MATTER comes before the Court on Defendant PALM, INC.'s Motions to Strike Paragraphs 69–71 of the Complaint, filed as Docket Entry No. 16, and to Stay, filed as Docket Entry No. 18. For the reasons set forth herein, these motions shall be GRANTED. The above-referenced paragraphs shall be STRICKEN from the Complaint, and the matter shall be STAYED until the validity of the patents-in-suit is resolved by the Patent & Trademark Office and through any consequent appeals.

I.

In November 2006, NTP filed this action for patent infringement against Palm with respect to seven specific patents[1] utilized by several of the latter's wireless communication products. All of the claims of the patents-in-suit identified in NTP's Complaint have been the subject of reexamination proceedings. In February 2006, the Examiners of the Patent &

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[1] The patents-in-suit are: (1) U.S. Patent No. 5,436,960 ("the '960 patent); (2) U.S. Patent No. 5,438,611 ("the '611 patent"); (3) U.S. Patent No. 5,625,670 ("the '670 patent); (4) U.S. Patent No. 5,819,172 ("the '172 patent"); (5) U.S. Patent No. 6,067,451 ("the '451 patent"); (6) U.S. Patent No. 6,317,592 ("the '592 patent"); and (7) U.S. Patent No. 5,479,472 ("the '472 patent").

EXHIBIT
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Trademark Office ("the PTO") issued final office actions rejecting claims of the '960 and '451 patents, having determined that NTP was not the first in time to invent its patent claims. The PTO also rejected a host of claims in the '592 patent, and issued an office action closing prosecution in an inter partes reexamination. Final rejections of the four remaining patents-in-suit were issued in August 2006 on the same basis as the '960 and the '451 patents' rejections. NTP has begun the process of appealing these decisions.[2] As a result of the PTO's reexamination of the patents-in-suit, all claims asserted against Palm have been rejected by the PTO as unpatentable during reexamination.

II.

The first matter to address is Palm's Motion to Strike Paragraphs 69–71 of the Complaint. In general, these paragraphs allege that the PTO has engaged in improper ex parte communications with a third party[3] regarding the reexamination of the patents-in-suit, and that the consequence of these communications has been the corruption of the reexamination process. It is therefore urged that the Court refrain from deferring to the judgment of the PTO in rejecting the patents' validity and allow Paragraphs 69–71 to remain.

For two reasons, however, the Court declines to do so. The first is jurisdictional. Title 35 of the United States Code establishes venue for appeals from an adverse decision from an examination proceeding to either the Court of Appeals for the Federal Circuit or to the United States District Court for the District of Columbia. 35 U.S.C. §§ 141, 145, 306. There is no indication that Congress intended these jurisdictional restraints to be limited exclusively to direct challenges of the decisions rendered in examination proceedings. Because there is no reason to suppose that this Court may do indirectly what it is without jurisdiction to do directly, we may presume collateral challenges to patent proceedings to be as equally prohibited when raised in an improper venue. And that is the circumstance presently before the Court. NTP is attempting to use a patent infringement action against a private corporation to impugn the validity of the patent reexamination process. Paragraphs 69–71 have been stated for that purpose. Were the Court to tolerate these allegations, it would be necessary to disregard Congress's exclusive grant of jurisdiction. That invitation is declined.

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[2] NTP has filed Appeals Briefs regarding the decisions on claims of the '960 and '451 patents, and has also filed Notices of Appeal in the '611, '670, '172, and '472 patents. It is not known whether NTP has initiated the process of appeal regarding the '592 patent.

[3] The "third party" herein referenced is Research In Motion, Inc.

The second reason that these allegations must be stricken is a consequence of their slight relevance. Paragraphs 69–71 relate solely to allegations of impropriety between the PTO and a third party, neither of which are present in this action. Palm is concerned, and legitimately so, that any evidence of a third party having exercised undue influence on the PTO, or otherwise engaging in unethical conduct with respect to any of its Examiners, would serve only to confuse the issues in the conscience of the jury and tempt the possibility that the third-party's conduct would be unfairly attributed to Palm. Any probative value that evidence supporting the disputed allegations may have would be substantially outweighed by its prejudicial effect.

Federal Rule of Civil Procedure 12(f) provides that the Court may order stricken from a pleading any matter that is immaterial or impertinent. "An allegation is 'impertinent' or 'immaterial' when it is [not] relevant to the issues involved in the action." 2 James Wm. Moore et al., Moore's Federal Practice § 12.37[3] (3d ed. 2006). "To prevail on this motion to strike, the movant must clearly show that the challenged matter has no bearing on the subject matter of the litigation and that its inclusion will prejudice the defendants." Id. (citations and internal quotations omitted); Clark v. Milam, 152 F.R.D. 66, 70 (S.D. W. Va. 1993). Whether to grant a motion to strike is a matter that is within the exercise of this Court's sound discretion. United States v. Poore, 594 F.2d 39, 41 (4th Cir. 1979). Upon due consideration, it is the judgment of the Court that the circumstances alleged in Paragraphs 69–71 are immaterial and impertinent, that their inclusion is likely to induce unfair prejudice against the Defendant, and that those paragraphs must therefore be stricken from the Complaint.

III.

Palm has also moved to stay these proceedings pending the outcome of the PTO's reexamination of the patents-in-suit. There can be no question regarding the Court's natural authority to order certain matters stayed in its discretion, Landis v. N. Am. Co., 299 U.S. 248, 254 (1936), or that this power may be exercised to stay a matter touching upon a patent's validity while the PTO engages in a reexamination of the underlying claim, Gould v. Control Laser Corp., 705 F.2d 1340, 1342 (Fed. Cir. 1983). The Court's discretion to grant a stay is not without limit, though, and its analysis should be guided with reference to a number of considerations, including: (1) whether discovery is complete and whether a trial date has been set; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party. E.g., Tap Pharmaceutical Prods., Inc. v. Atrix Labs., Inc., 70 U.S.P.Q.2d 1319, 1320 (N.D. Ill. 2004).

This civil action was instituted in November 2006; that December, this Motion was submitted by the Defendant; at the end of January, the Court heard oral argument. Since then, the parties have exchanged a limited amount of discovery, and there are several motions pending that address certain disputes that have arisen in the course of that process.[4] Discovery is far from complete, and the Court has yet to establish firm dates for the management of this case; not even a trial date has been set. We remain in the early stages of the litigation, when the time invested and the resources spent is not so great as to compel this Court's continuing involvement.

At the same time, there appear to be significant benefits to staying this matter until the validity of the patents-in-suit may be established. It is entirely possible that the PTO will determine that such patents were wrongly issued and that the Plaintiff is not the owner of the interests in dispute. In that event, NTP would ostensibly lack the standing necessary to bring an action for infringement, and the case would be dismissed. The chance that this might occur is more than passing. As mentioned previously, NTP has appealed, or is in the process of appealing, adverse decisions from the PTO regarding the validity of each of its claims to the patents-in-suit. It would be a painful tragedy—for everyone involved—if this litigation were allowed to move forward during the PTO's reexamination, only to be rendered meaningless by that agency's final action. Cf. Chevron v. Natural Res. Def. Council, Inc., 467 U.S. 837 (1984).

But that is not the only way in which a stay would simplify these issues. There is also the possibility that the PTO will reverse its course and find that the Plaintiff is the rightful owner of the patents-in-suit. Once the case returns from the holding pattern to which it will be sent, the parties and the Court will have the PTO's expert opinion regarding the scope and validity of the patent claims, e.g., Am. Online, Inc. v. AT&T, 243 F.3d 812, 816 (4th Cir. 2001), and both will be in a better position to assess the issues raised in this civil action.

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[4] The parties have filed cross-motions for protective orders governing discovery and the handling of confidential materials. In addition, Plaintiff NTP has moved to compel production of certain matters from Defendant Palm. The Court shall dispose of these motions in separate orders.

We come finally to the matter of prejudice. The Plaintiff contends that it stands to suffer serious and irreparable harm should the Court choose to stay these proceedings; not only will NTP suffer clouds over its patents, it will lose the opportunity to enjoin their further infringement.[5] The Court is sympathetic to the Plaintiff's position, but is also mindful of the fair possibility that the PTO will determine the Plaintiff's claims to be unenforceable. It cannot be understated: because NTP's claims are wholly predicated on patents whose validity is currently under examination, the invalidation of those patents will render this civil action moot. There is simply no reason to justify the maintenance and expense of this action during the pendency of an examination whose resolution could summarily resolve these matters.

It therefore appears that a stay is necessary to avoid further and improvident expenditure of time and resources.

IV.

Upon due consideration, and for the foregoing reasons, the Defendant's Motions to Strike and to Stay are GRANTED. Let the Clerk send a copy of this Order to all counsel of record.

It is SO ORDERED.

James R. Spencer
CHIEF UNITED STATES DISTRICT JUDGE

ENTERED this 22nd day of March 2007

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[5] Of course, once it is established that the Plaintiff's claims to the patents-in-dispute are valid and enforceable, NTP could renew its request for injunctive relief. In addition, monetary damages would presumably be available for any infringement that occurred prior to the time of the granting of an injunction, if at all. Cf. eBay Inc. v. MercExchange, L.L.C., 126 S. Ct. 1837 (2006).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/006,533	5436960	
	Examiner	Art Unit	
	Lester G. Kincaid	2685	

--*The **MAILING DATE** of this communication appears on the cover sheet with the correspondence address*--

The request for *ex parte* reexamination filed 30 January 2003 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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cc:Requester (if third party requester)

Reexamination

1. A substantial new question of patentability affecting claims 1-89 of United States Patent Number 5,436,960 is raised by the request for reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

The request indicates that the Requester considers claims 1-89 to be unpatentable over the "Beginners guide to TCP/IP on the Amateur Packet Radio Network using the KA9Q Software", Perkins, and the Aloha Net.

It is agreed that consideration of the references raises a substantial new question of patentability as to claims 1-89 of the Campana, Jr. et al. patent (5,436,960). As pointed out in the claim charts applying each reference to the recited limitations of the independent patented claims, the references reasonably convey a system including each of the claimed features. None of the references were previously of record or previously considered in the prosecution of the application that became the Campana, Jr. et al. patent. Further, there is a substantial likelihood that a reasonable examiner would consider the teachings, either alone or in combination, as material to the decision of patentability of the Campana, Jr. et al. claims. Accordingly, the cited references raise a substantial new question of patentability of claims 1-89, which question has not been decided in a previous examination of the Campana, Jr. et al. patent.

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,436,960 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Lester Kincaid
Primary Examiner AU 2685

Lester Kincaid
4/9/03

Allen MacDonald

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,676	06/24/2003	5438611		5438

20457 7590 09/03/2003

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

E0000000 " 54386006

Copy to: third party
David L. Stewart

PTO-90C (Rev. 07-01)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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Orlando FL 32801

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006676

PATENT NO. 5,438,611

ART UNIT 2681

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/006,676	Patent Under Reexamination 5438611	
	Examiner Lester G. Kincaid	Art Unit 2685	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed *24 June 2003* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

Reexamination

1. A substantial new question of patentability affecting claims 1-80 of United States Patent Number 5,438,611 is raised by the request for reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

Issues Raised in the Request

The Request for Reexamination incorporates a LIST OF APPENDICES and also provides a PTO-1449 form, both of which list pertinent prior art to be considered in the Request. The Request is somewhat confusing in that the LIST OF APPENDICES and the PTO-1449 both refer to listed prior art using different identifiers. For example, reference "B1" on the LIST OF APPENDICES appears to be identical to reference "AD" on the PTO-1449; and reference "B2" on the LIST OF APPENDICES appears to be coincide with reference "AE" on the PTO-1449. Furthermore, some of the 'references' listed in the LIST OF APPENDICES (such as references "B3", "C1" and "D1") are not listed on the PTO-1449, inasmuch as they are claim charts (not prior art) provided by the requester.

Furthermore, the choice of language used to set forth the issues raised in the request are confusing. For example, the Request sets forth that each of the independent claims is "anticipated" by single "reference B1 (GSM/X.400) as explained by references B2 and B4". Yet the "(GSM/X.400)" identifier following reference "B1" implies it must be the combination of at least B1 and B2 together which are to be considered inasmuch as "B1" is the GSM report and "B2" is the X.400 standard.

In an effort to clarify the record, the following paragraphs set forth the examiner's best interpretation of each issue raised in the request. **Furthermore, for consistency, all prior art references have been identified in parentheses by the identifiers they have been provided with the on the PTO-1449, hereafter "1449".**

2. The request indicates that the Requester considers claims 1, 46, and 55 to be unpatentable over each of the following references:

(1) the integration of GSM and X.400 (hereafter GSM/X.400 system) as described in GSM Report 03-42 (1449-AD) entitled "Advanced MHS Access" in combination with references entitled CCITT Standard X.400 (1449 - AE) and "Architectural Aspects of Data and Telematic Services in a GSM PLMN" by Graham Crisp and Alfons Eizenhoefer from the Proceedings of the Third Nordic Seminar on Digital Land Mobile Radio Communications, September 12-15, 1988 in Copenhagen (1449 - AF);

(2) the GSM/X.400 system (as also disclosed by references AD, AE, and AF), but relying on the SMS feature (hereafter GSM/SMS system);

(3) Perkins (1449 - AB);

(4) Zabarsky et al. (1449 - AC);

(5) the printed document entitled "The AlohaNet" (1449 - AG) in combination with Computer Structures: Principles and Examples (1449 - AH), (the combination hereafter The AlohaNet documents);

(6) the combination of the SAM Reference Manual (1449 - AI) and SAM User Manual (1449 - AJ), the combination herefter noted as "TekNow-SAM system";

(7) the combination of references Beginner's Guide to TCP/IP on the Amateur Radio Packet Radio Network Using the KA9Q Internet Software (1449 - AQ) in combination with KA9Q Internet Software Package (1449 - AR), Portable RTTY Operation (1449 - AS), Your Gateway to Packet Radio (1449 - AT), PSR Quarterly -- Sarex II, "Packet Radio from the Shuttle" (1449 - AU), ARRL AMATEUR RADIO 5th Computer Network Conference (1449 - AV), ARRL AMATEUR RADIO 6th Computer Network Conference (1449 - AW), ARRL AMATEUR RADIO 7th Computer Network Conference (1449 - AX), ARRL AMATEUR RADIO 8th Computer Network Conference (1449 - AY), and ARRL AMATEUR RADIO 9th Computer Network Conference (1449 - AZ), the combination hereafter noted as "KA9Q Software",

and claims 2-45, 47-54, and 56-80 to be unpatentable over each of the above named references individually in conjunction with admissions of prior art in the Campana, Jr. et al patent specification.

3. It is agreed that consideration of the references raises a substantial new question of patentability as to claims 1-80 of the Campana, Jr. et al. patent (5,436,960). As pointed out in the claim charts applying each reference to the recited limitations of the

independent patented claims, the references reasonably convey a system including each of the claimed features. Of the references, only Zabarsky et al. was previously of record and previously applied in the prosecution of the application that became the Campana, Jr. et al. patent. Regarding Zabarsky et al., the requester has detailed a new interpretation of Zabarsky et al. which reasonably provides for a substantial new question of patentability. Further, there is a substantial likelihood that a reasonable examiner would consider the other teachings, either alone or in combination, as material to the decision of patentability of the Campana, Jr. et al. claims. In addition, as pointed out in the claim charts applying the admitted prior art to the recited limitations of the dependent patented claims, the references in conjunction with the admitted prior art reasonably convey a system including each of the claimed features. Accordingly, the cited references raise a substantial new question of patentability of claims 1-80, which question has not been decided in a previous examination of the Campana, Jr. et al. patent.

4. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,438,611 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Lester Kincaid
Primary Examiner AU 2685
9/2/03

ALLEN R. MACDONALD
DIRECTOR
TECHNOLOGY CENTER 2600

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

CONTROL NUMBER	ORDER DATE	PATENT NUMBER	PATENTEE
90/006,491	December 26, 2002	5,625,670	Campana et al.

ANTONELLI, TERRY, STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

EXAMINER	
Dwayne Bost	
ART UNIT	PAPER NUMBER
2681	1

DATE MAILED: December 26, 2002

DIRECTOR INITIATED ORDER FOR REEXAMINATION

Attachment(s): ☒ PTO-892. ☐ PTO-1449.
☐ Other: ____________________

Response Time For Patent Owner's Statement:

TWO MONTHS from the date hereof. 37 CFR 1.530(b).

Notes: If the patent owner does not file a timely statement under 37 CFR 1.530(b), reexamination will proceed in accordance with 37 CFR 1.550(a).

An identification of the claims, the references relied on, and the rationale of the decision to order reexamination is attached.

REEXAMINATION ORDER:

Pursuant to 37 CFR 1.520, reexamination is ordered. Note the attached decision.

Pursuant to 37 CFR §1.520 the Director of the United States Patent and Trademark Office has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-276 of U.S. Patent No 5,625,670.

RELEVANT PRIOR ART

[1] Textbook Computer Structures: Principles and Examples, chapters 5, 24 and 25, by Siewiorek et al., published by McGraw-Hill book Company, copyright 1982.

[2] Heart et al., (Bolt Bernack and Newman, Inc.), "The interface message processor for the ARPA computer network," Spring Joint Computer Conference Proceeding, 1970, pp. 551-567.

[3] S.M.Ornstein et al., (Bolt Bernack and Newman, Inc.), "The Terminal IMP for the ARPA Computer Network," AFIPS Conference Proceedings, June 1972, pp. 243-254.

[4] Cerf, V.G., and Kahn, R.E. "A protocol for packet network intercommunication," IEEE Transactions on Communications, vol. Com-22, May 1974, pp. 637-648.

[5] Binder, R. et al. (Hawaii University Honolulu), "ALOHA Packet Broadcasting – A Retrospect," January 1975, 25 pgs. (contract number: NAS2-8590, ARPA Order-1956).

[6] Binder, R. et al. (University of Hawaii Honolulu, Hawaii), THE ALOHANET MENEHUE – VERSION II, ARPA Order-1956, September 1974, pp. 1-55.

[7] Binder, R. (University of Hawaii) ALOHANET PROTOCOLS, ARPA Order No. 1956., September 1974, pp. 1-36.

[8] Abrahmson, N., "Development of the ALOHANET," IEEE Transactions on Information Theory, Vol. IT-31, No. 2, March 1985, pp. 119-123.

[9] Roberts, L., "Data by the Packet," IEEE Spectrum, Vol. 11, pp. 46-51, February 1974.

[10] Nelson, H.A., "The ARPANET IMP (Interface Message Processor) Port Expander," pp. 1- 48, November 1980.

[11] U.S. Patent 5,159,592 (Perkins), issued Oct. 27, 1992, filed Oct. 29, 1990.

DECISION

The claims of the 670 patent are drawn to a system and method for connecting e-mail systems and hence electronic mail to an RF transmission network and ultimately to a specific RF receiver.

Claim 1 is exemplary:

> A system for transmitting information from one of a plurality of originating processors contained in an electronic mail system to at least one of a plurality of destination processors contained in an electronic mail system with the information including originated information originating from one of the plurality of originating processors and being transmitted by an RF information transmission network to at least one of the plurality of destination processors and other originated information originating from one of the originating processors is transmitted with the electronic mail system without using the RF information transmission network to at least one of the destination processors comprising:
>
> at least one interface, one of the at least one interface connecting the electronic mail system containing the plurality of originating processors to the RF information transmission network; and wherein
>
> the originated information is transmitted in association with an address of the one interface from the one of the plurality of originating processors to the one interface with the electronic mail system responding to the address of the one interface to direct the originated information from the one of the plurality of originating processors to the one interface; and
>
> the originated information is transmitted from the one of the at least one interface to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information being added at the originating processor originating the originated information, or by either the electronic mail system that contains the plurality of originating processors or the one interface.

References [1]-[10]

References [1]-[10] describe a system, method and details related to the equipment and protocols used to link computers together to form the ARPA Network (forefather of today's Internet) [1]. The ARPA Network links numerous host computers (read on originating processors w/in an electronic mail system) together. A host may send a message to another specific host (in which the specific host would then be read as a destination processor). The data which is transmitted by an origination host includes information as to the destination. This data is received via an IMP or

Interface Message Processor. The IMP or more flexible TIP (an IMP with a flexible terminal handling capability) [2] is the backbone for routing w/in the ARPA Network. [1]. The IMP or TIP would accept the data, split the data into packets, add header information which included the source and destination address for each packet (read on interface addressing) and broadcast the packets to other IMPs within the system for ultimate accumulation and reassembly of each packet in turn in order to retrieve the original data for delivery of the intact data to the destination host processor [2] [3] [4] [9]. Reference [1] provides good pictorial layouts of the ARPA Network 1979, (section 5, Figures 10 and 11, pp. 397-398). As can be seen, there are wired connections coupling the various host/IMPs covering the continental United States (read on originated information originating from one of the originating processors and transmitted with the electronic mail system without using an RF information transmission network).

Depicted in the figures referenced above (and described in references [1] [5] [6] [7] [8]) the ARPA Network was also interfaced with an RF information transmission network, i.e., the ALOHANET, wherein information/electronic message/data, etc. originating from a host (originating) processor within the ARPA Network was deliverable to a host (destination) processor within the ALOHANET via a TIP or IMP (MENEHUE). The MENEHUE or ALOHANET's IMP received information from other IMPs within the ARPA Network (or from within the ALOHANET system for internal delivery or delivery to an IMP and destination host processor within the ARPA Network) and would operate in the same fashion to gather all of the packets together, to recover the original information/data/electronic message, etc. The ALOHANET is read on an RF information transmission network coupling destination processor together as well as to the ARPA Network.

The MENEHUE is read on the at least one addressed interface connecting an electronic mail system to the RF information transmission network in that the manner of transmitting data/information/electronic messages, etc. to the other processors within the ALOHANET system is accomplished via radio packet broadcasting. Information received from a host (originating) processor within the ARPA Network for example, would be received by the ALOHANET, assembled and then packetized with the specific destination processor/receiver address. The information is transmitted via a radio packetized broadcast via the MENEHUE, wherein either a repeater or host (destination) processor terminal unit, with the appropriate address only, would receive and process the transmitted information. [5] [6] [7] [8].

The origination or host processor, within either connected network (ARPA Network or ALOHANET) would add the destination information to the originated information in order for the information to be routed correctly in the first place. The previous paragraph's example of a host processor sending information/data/electronic message etc. to a destination processor in the ALOHANET, reads on the claim limitation whereby the originated information is transmitted from the one interface (IMP connected to the host processor initiating the transmission) to the RF information transmission network with an address for a specific destination processor (i.e., one in which requires a radio packet broadcast in order to reach in the ALOHANET). [5] [6] [7] [8].

Reference [11] (U.S. Patent to Perkins)

The Perkins patent describes an INTERNET based system which allows for packet switch routing of information/data/electronic messages etc. between host processors across the Internet. This process is similar to that described with respect to the ARPA Network above (the ARPA Network was the forefather of Today's Internet). The problem that Perkins addresses has to deal with the connection of mobile communication units to LANs for addressing via packets routed from wired electronic mail systems into the wireless or RF transmission network.

The backbone of the INTERNET includes the host processors, routers, packeting processes as described previously, which reads on the claimed origination and destination processors (destinations not connected via an RF network) and interface routing via packeting processes which includes source and destination addressing. The problem the Perkins foresaw dealt with the addressing of mobile or non-fixed (RF) units. Fixed or wired Internet connection would have a permanently assigned TCP/IP routing address. If an end terminal were mobile, such as suggested by Perkins, then a fixed routing address would not work.

Perkins suggests a system/method for connecting the wired network to mobile users within an RF transmission network, see column 2, lines 4-10, lines 55-65; and column 3, lines 1-15. Column 3, lines 23-26 describe the local gateway as the interface device between the wired network and the RF transmission network with lines 5-8 stating that the routers of the wired Internet are instructed to forward packets destined for the wireless transmission network, to the global gateway. This reads on the addressing of the packets from an origination processor to the interface (global gateway) which connects the electronic mail system (INTERNET) to the RF information transmission network

Perkins goes on to describe that a mobile device may register with a particular LAN (local area network) by transmitting a unique identifier, such as its serial number, that is permanently stored within a memory of the mobile unit 10. The gateway (read as interface to RF transmission network) then associates this mobile ID with a pseudo-IP address which is assigned to the mobile device on a dynamic basis, column 5, lines 57-65. When the global gateway (interface) receives data/information/electronic message for a specific mobile unit (routed via destination address and delivered to the gateway) the gateway matches the received data to a dynamically assigned pseudo-IP address for the mobile and transmits the message to the appropriate LAN which broadcasts to the proper destination mobile (read on destination processor). Inherently the global gateway must have from the incoming packets, information with respect to the destination mobile which is entered from the origination processor, in order to associate the received packetized information/data/electronic message etc. for delivery to a specific mobile unit, see column 4, lines 25-60. Column 7, lines 54-56 and Column 8 lines 33-39 of Perkins provide examples of packet routing from the viewpoint of the mobile unit acting as origination processor. The IP address of the destination (remote user) processor is added to original data being transmitted and wherein the origination processor (mobile unit) adds header information to outgoing data so that the remote user (destination processor) knows that the data was initiated from the specific source, i.e. the mobile device. This example of TCP/IP routing demonstrates the claim limitations of adding address information at an origination processor originating the originated information.

CONCLUSION

In view of the above patent and printed publications and their teachings, a substantial new question of patentability is raised as to claims 1-276 of U.S. Patent 5,625,670. Reexamination of U.S. Patent 5,625,670 is ordered under 37 CFR § 1.520. All the patent claims will be reexamined.

Robert Frai, for

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

CONTROL NUMBER	ORDER DATE	PATENT NUMBER	PATENTEE
90/006,493	December 26, 2002	5,819,172	Campana et al.

ANTONELLI, TERRY, STOUT AND KRAUS
SUITE 1800
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EXAMINER	
Dwayne Bost	
ART UNIT	PAPER NUMBER
2681	1

DATE MAILED: **December 26, 2002**

DIRECTOR INITIATED ORDER FOR REEXAMINATION

Attachment(s): ☒ PTO-892. ☐ PTO-1449.
☐ Other: ____________________

Response Time For Patent Owner's Statement:

TWO MONTHS from the date hereof. 37 CFR 1.530(b).

Notes: If the patent owner does not file a timely statement under 37 CFR 1.530(b), reexamination will proceed in accordance with 37 CFR 1.550(a).

An identification of the claims, the references relied on, and the rationale of the decision to order reexamination is attached.

REEXAMINATION ORDER:

Pursuant to 37 CFR 1.520, reexamination is ordered. Note the attached decision.

Reexamination Control No. 90/006,493

Pursuant to 37 CFR §1.520 the Director of the United States Patent and Trademark Office has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-223 of U.S. Patent No 5,819,172

RELEVANT PRIOR ART

[1] Textbook Computer Structures: Principles and Examples, chapters 5, 24 and 25, by Siewiorek et al., published by McGraw-Hill book Company, copyright 1982.

[2] Heart et al., (Bolt Bernack and Newman, Inc.), "The interface message processor for the ARPA computer network," Spring Joint Computer Conference Proceeding, 1970, pp. 551-567.

[3] S.M.Ornstein et al., (Bolt Bernack and Newman, Inc.), "The Terminal IMP for the ARPA Computer Network," AFIPS Conference Proceedings, June 1972, pp. 243-254.

[4] Cerf, V.G., and Kahn, R.E. "A protocol for packet network intercommunication," IEEE Transactions on Communications, vol. Com-22, May 1974, pp. 637-648.

[5] Binder, R. et al. (Hawaii University Honolulu), "ALOHA Packet Broadcasting – A Retrospect," January 1975, 25 pgs. (contract number: NAS2-8590, ARPA Order-1956).

[6] Binder, R. et al. (University of Hawaii Honolulu, Hawaii), THE ALOHANET MENEHUE – VERSION II, ARPA Order-1956, September 1974, pp. 1-55.

[7] Binder, R. (University of Hawaii) ALOHANET PROTOCOLS, ARPA Order No. 1956., September 1974, pp. 1-36.

[8] Abrahmson, N., "Development of the ALOHANET," IEEE Transactions on Information Theory, Vol. IT-31, No. 2, March 1985, pp. 119-123.

[9] Roberts, L., "Data by the Packet," IEEE Spectrum, Vol. 11, pp. 46-51, February 1974.

[10] Nelson, H.A., "The ARPANET IMP (Interface Message Processor) Port Expander," pp. 1- 48, November 1980.

[11] U.S. Patent 5,159,592 (Perkins), issued Oct. 27, 1992, filed Oct. 29, 1990.

DECISION

The claims of the 172 patent are drawn to a system and method for connecting e-mail systems and hence electronic mail to an RF transmission network and ultimately to a specific RF receiver.

Claim 99 is exemplary:

> A system for transmitting an inputted message, contained in an electronic mail message originating from one of a plurality of originating processors contained in at least one electronic mail system, to at least one RF receiver with at least the inputted message being transmitted by an RF information transmission system to the at least one RF receiver comprising:
>
> at least one interface, one of the at least one interface connecting the at least one electronic mail system containing the plurality of originating processors to the RF information transmission system; and wherein
>
> the electronic mail message originating from one of the plurality of originating processors includes an address of the one interface and is transmitted from the oneof the plurality of originating processors to the one interface which processes the electronic mail message with the one of the at least one electronic mail system responding to the address of the one interface to direct the electronic mail message from the one of the plurality of originating processors to the one interface;
>
> the RF information transmission system transmits at least the inputted message from the one interface through the RF information transmission system to the at least one RF receiver after information is inputted to the system; and
>
> at least one additional information source, each additional information source being coupled to at least one of the at least one interface and originating other information from outside any of the at least one electronic mail system for transmission to at least one RF receiver and information used by the RF information transmission system to identify the at least one RF receiver to receive the other information with the RF information transmission system providing transmission of the other information through the RF information transmission system to the identified at least one RF receiver receiving the other information.

References [1]-[10]

References [1]-[10] describe a system, method and details related to the equipment and protocols used to link computers together to form the ARPA Network (forefather of today's Internet) [1].

The ARPA Network links numerous host computers (read on originating processors w/in an electronic mail system) together. A host may send a message to another specific host (in which the specific host would then be read as a destination processor). The data which is transmitted by an origination host includes information as to the destination. This data is received via an IMP or Interface Message Processor. The IMP or more flexible TIP (an IMP with a flexible terminal handling capability) [2] is the backbone for routing w/in the ARPA Network. [1]. The IMP or TIP would accept the data, split the data into packets, add header information which included the source and destination address for each packet (read on interface addressing) and broadcast the packets to other IMPs within the system for ultimate accumulation and reassembly of each packet in turn in order to retrieve the original data for delivery of the intact data to the destination host processor [2] [3] [4] [9]. Reference [1] provides good pictorial layouts of the ARPA Network 1979, (section 5, Figures 10 and 11, pp. 397-398). As can be seen, there are wired connections coupling the various host/IMPs covering the continental United States (read on originated information originating from one of the originating processors and transmitted with the electronic mail system without using an RF information transmission network).

Depicted in the figures referenced above (and described in references [1] [5] [6] [7] [8]) the ARPA Network was also interfaced with an RF information transmission network, i.e., the ALOHANET, wherein information/electronic message/data, etc. originating from a host (originating) processor within the ARPA Network was deliverable to a host (destination) processor within the ALOHANET via a TIP or IMP (MENEHUE). The MENEHUE or ALOHANET's IMP received information from other IMPs within the ARPA Network (or from within the ALOHANET system for internal delivery or delivery to an IMP and destination host processor within the ARPA Network) and would operate in the same fashion to gather all of the packets together, to recover the original information/data/electronic message, etc. The ALOHANET is read on an RF information transmission network coupling destination processor together as well as to the ARPA Network.

The MENEHUE is read on the at least one addressed interface connecting an electronic mail system to the RF information transmission network in that the manner of transmitting data/information/electronic messages, etc. to the other processors within the ALOHANET system is accomplished via radio packet broadcasting. Information received from a host (originating) processor within the ARPA Network for example, would be received by the ALOHANET, assembled and then packetized with the specific destination processor/receiver address. The information is transmitted via a radio packetized broadcast via the MENEHUE, wherein either a repeater or host (destination) processor terminal unit, with the appropriate address only, would receive and process the transmitted information. [5] [6] [7] [8].

The origination or host processor, within either connected network (ARPA Network or ALOHANET) would add the destination information to the originated information in order for the information to be routed correctly in the first place. The previous paragraph's example of a host processor sending information/data/electronic message etc. to a destination processor in the

ALOHANET, reads on the claim limitation whereby the originated information is transmitted from the one interface (IMP connected to the host processor initiating the transmission) to the RF information transmission network with an address for a specific destination processor (i.e., one in which requires a radio packet broadcast in order to reach in the ALOHANET). [5] [6] [7] [8].

With specific respect to the limitation of "at least one additional information source, each additional information source being coupled to at least one of the at least one interface and originating other information from outside any of the at least one electronic mail system for transmission to at least one RF receiver" references [4] and [10] outline, e.g., the concept of TCP and Gateways which link the ARPA Network to other Networks around the Globe, as well as description of an IMP Port Expander (as depicted in Figure 1 of reference [10]) a Port expander would allow for other networks through a gateway, connect to an interface (i.e., IMP) within the ARPA Network, which as explained above permitted connection to the RF information network ALOHANET.

Reference [11] (U.S. Patent to Perkins)

The Perkins patent describes an INTERNET based system which allows for packet switch routing of information/data/electronic messages etc. between host processors across the Internet. This process is similar to that described with respect to the ARPA Network above (the ARPA Network was the forefather of Today's Internet). The problem that Perkins addresses has to deal with the connection of mobile communication units to LANs for addressing via packets routed from wired electronic mail systems into the wireless or RF transmission network.

The backbone of the INTERNET includes the host processors, routers, packeting processes as described previously, which reads on the claimed origination and destination processors (destinations not connected via an RF network) and interface routing via packeting processes which includes source and destination addressing. The problem the Perkins foresaw dealt with the addressing of mobile or non-fixed (RF) units. Fixed or wired Internet connection would have a permanently assigned TCP/IP routing address. If an end terminal were mobile, such as suggested by Perkins, then a fixed routing address would not work.

Perkins suggests a system/method for connecting the wired network to mobile users within an RF transmission network, see column 2, lines 4-10, lines 55-65; and column 3, lines 1-15. Column 3, lines 23-26 describe the local gateway as the interface device between the wired network and the RF transmission network with lines 5-8 stating that the routers of the wired Internet are instructed to forward packets destined for the wireless transmission network, to the global gateway. This reads on the addressing of the packets from an origination processor to the interface (global gateway) which connects the electronic mail system (INTERNET) to the RF information transmission network

Perkins goes on to describe that a mobile device may register with a particular LAN (local area network) by transmitting a unique identifier, such as its serial number, that is permanently stored within a memory of the mobile unit 10. The gateway (read as interface to RF transmission network) then associates this mobile ID with a pseudo-IP address which is assigned to the mobile device on a dynamic basis, column 5, lines 57-65. When the global gateway (interface) receives data/information/electronic message for a specific mobile unit (routed via destination address and delivered to the gateway) the gateway matches the received data to a dynamically assigned pseudo-IP address for the mobile and transmits the message to the appropriate LAN which broadcasts to the proper destination mobile (read on destination processor). Inherently the global gateway must have from the incoming packets, information with respect to the destination mobile which is entered from the origination processor, in order to associate the received packetized information/data/electronic message etc. for delivery to a specific mobile unit, see column 4, lines 25-60. Column 7, lines 54-56 and Column 8 lines 33-39 of Perkins provide examples of packet routing from the viewpoint of the mobile unit acting as origination processor. The IP address of the destination (remote user) processor is added to original data being transmitted and wherein the origination processor (mobile unit) adds header information to outgoing data so that the remote user (destination processor) knows that the data was initiated from the specific source, i.e. the mobile device. This example of TCP/IP routing demonstrates the claim limitations of adding address information at an origination processor originating the originated information.

CONCLUSION

In view of the above patent and printed publications and their teachings, a substantial new question of patentability is raised as to claims 1-223 of U.S. Patent 5,819,172. Reexamination of U.S. Patent 5,819,172 is ordered under 37 CFR § 1.520. All the patent claims will be reexamined.

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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UNITED STATES PATENT AND TRADEMARK OFFICE
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DIRECTOR OF THE UNITED STATES PATENT
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Washington, D.C. 20231

CONTROL NUMBER	ORDER DATE	PATENT NUMBER	PATENTEE
90/006,494	December 26, 2002	6,067,451	Campana et al.

ANTONELLI, TERRY, STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

EXAMINER	
Dwayne Bost	
ART UNIT	PAPER NUMBER
2681	1

DATE MAILED: December 26, 2002

DIRECTOR INITIATED ORDER FOR REEXAMINATION

Attachment(s): ☒ PTO-892. ☐ PTO-1449.
☐ Other: ____________________ .

Response Time For Patent Owner's Statement:

TWO MONTHS from the date hereof. 37 CFR 1.530(b).

Notes: If the patent owner does not file a timely statement under 37 CFR 1.530(b), reexamination will proceed in accordance with 37 CFR 1.550(a).

An identification of the claims, the references relied on, and the rationale of the decision to order reexamination is attached.

REEXAMINATION ORDER:

Pursuant to 37 CFR 1.520, reexamination is ordered. Note the attached decision.

Pursuant to 37 CFR §1.520 the Director of the United States Patent and Trademark Office has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-341 of U.S. Patent No 6,067,451.

RELEVANT PRIOR ART

[1] Textbook Computer Structures: Principles and Examples, chapters 5, 24 and 25, by Siewiorek et al., published by McGraw-Hill book Company, copyright 1982.

[2] Heart et al., (Bolt Bernack and Newman, Inc.), "The interface message processor for the ARPA computer network," Spring Joint Computer Conference Proceeding, 1970, pp. 551-567.

[3] S.M.Ornstein et al., (Bolt Bernack and Newman, Inc.), "The Terminal IMP for the ARPA Computer Network," AFIPS Conference Proceedings, June 1972, pp. 243-254.

[4] Cerf, V.G., and Kahn, R.E. "A protocol for packet network intercommunication," IEEE Transactions on Communications, vol. Com-22, May 1974, pp. 637-648.

[5] Binder, R. et al. (Hawaii University Honolulu), "ALOHA Packet Broadcasting – A Retrospect," January 1975, 25 pgs. (contract number: NAS2-8590, ARPA Order-1956).

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[7] Binder, R. (University of Hawaii) ALOHANET PROTOCOLS, ARPA Order No. 1956., September 1974, pp. 1-36.

[8] Abrahmson, N., "Development of the ALOHANET," IEEE Transactions on Information Theory, Vol. IT-31, No. 2, March 1985, pp. 119-123.

[9] Roberts, L., "Data by the Packet," IEEE Spectrum, Vol. 11, pp. 46-51, February 1974.

[10] Nelson, H.A., "The ARPANET IMP (Interface Message Processor) Port Expander," pp. 1- 48, November 1980.

[11] U.S. Patent 5,159,592 (Perkins), issued Oct. 27, 1992, filed Oct. 29, 1990.

DECISION

The claims of the 451 patent are drawn to a system and method for connecting e-mail systems and hence electronic mail to an RF transmission network and ultimately to a specific RF receiver.

Claim 1 is exemplary:

> In a system comprising a communication system which transmits electronic mail, inputted to the communication system from a plurality of processors, and a RF system having a plurality of RF receivers which receive broadcasts from at least one broadcast location, the broadcast including information contained within the electronic mail and an identification of each RF receiver to receive the broadcast, an interface comprising:
>
> at least one input which receives at least the information contained within the electronic mail;
>
> at least one output which outputs a processed output, the processed output including the information contained within the electronic mail and an identification of each RF receiver which is to receive the broadcast of the information; and
>
> a processor, coupled to the at least one input and to the at least one output, which processes at least the information contained within the electronic mail to produce the processed output outputted by the at least one output.

References [1]-[10]

References [1]-[10] describe a system, method and details related to the equipment and protocols used to link computers together to form the ARPA Network (forefather of today's Internet) [1]. The ARPA Network links numerous host computers (read on originating processors w/in an electronic mail system) together. A host may send a message to another specific host (in which the specific host would then be read as a destination processor). The data which is transmitted by an origination host includes information as to the destination. This data is received via an IMP or Interface Message Processor. The IMP or more flexible TIP (an IMP with a flexible terminal handling capability) [2] is the backbone for routing w/in the ARPA Network. [1]. The IMP or TIP would accept the data, split the data into packets, add header information which included the source and destination address for each packet (read on interface addressing) and broadcast the packets to other IMPs within the system for ultimate accumulation and reassembly of each packet in turn in order to retrieve the original data for delivery of the intact data to the destination host processor [2] [3] [4] [9]. Reference [1] provides good pictorial layouts of the ARPA Network

1979, (section 5, Figures 10 and 11, pp. 397-398). As can be seen, there are wired connections coupling the various host/IMPs covering the continental United States (read on originated information originating from one of the originating processors and transmitted with the electronic mail system without using an RF information transmission network).

Depicted in the figures referenced above (and described in references [1] [5] [6] [7] [8]) the ARPA Network was also interfaced with an RF information transmission network, i.e., the ALOHANET, wherein information/electronic message/data, etc. originating from a host (originating) processor within the ARPA Network was deliverable to a host (destination) processor within the ALOHANET via a TIP or IMP (MENEHUE). The MENEHUE or ALOHANET's IMP received information from other IMPs within the ARPA Network (or from within the ALOHANET system for internal delivery or delivery to an IMP and destination host processor within the ARPA Network) and would operate in the same fashion to gather all of the packets together, to recover the original information/data/electronic message, etc. The ALOHANET is read on an RF information transmission network coupling destination processor together as well as to the ARPA Network.

The MENEHUE is read on the at least one addressed interface connecting an electronic mail system to the RF information transmission network in that the manner of transmitting data/information/electronic messages, etc. to the other processors within the ALOHANET system is accomplished via radio packet broadcasting. Information received from a host (originating) processor within the ARPA Network for example, would be received by the ALOHANET, assembled and then packetized with the specific destination processor/receiver address. The information is transmitted via a radio packetized broadcast via the MENEHUE, wherein either a repeater or host (destination) processor terminal unit, with the appropriate address only, would receive and process the transmitted information. [5] [6] [7] [8].

The origination or host processor, within either connected network (ARPA Network or ALOHANET) would add the destination information to the originated information in order for the information to be routed correctly in the first place. The previous paragraph's example of a host processor sending information/data/electronic message etc. to a destination processor in the ALOHANET, reads on the claim limitation whereby the originated information is transmitted from the one interface (IMP connected to the host processor initiating the transmission) to the RF information transmission network with an address for a specific destination processor (i.e., one in which requires a radio packet broadcast in order to reach in the ALOHANET). [5] [6] [7] [8].

Reference [11] (U.S. Patent to Perkins)

The Perkins patent describes an INTERNET based system which allows for packet switch routing of information/data/electronic messages etc. between host processors across the Internet. This process is similar to that described with respect to the ARPA Network above (the ARPA

Network was the forefather of Today's Internet). The problem that Perkins addresses has to deal with the connection of mobile communication units to LANs for addressing via packets routed from wired electronic mail systems into the wireless or RF transmission network.

The backbone of the INTERNET includes the host processors, routers, packeting processes as described previously, which reads on the claimed origination and destination processors (destinations not connected via an RF network) and interface routing via packeting processes which includes source and destination addressing. The problem the Perkins foresaw dealt with the addressing of mobile or non-fixed (RF) units. Fixed or wired Internet connection would have a permanently assigned TCP/IP routing address. If an end terminal were mobile, such as suggested by Perkins, then a fixed routing address would not work.

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Reexamination Control No. 90/006,494

CONCLUSION

In view of the above patent and printed publications and their teachings, a substantial new question of patentability is raised as to claims 1-341 of U.S. Patent 6,067,451 Reexamination of U.S. Patent 6,067,451 is ordered under 37 CFR § 1.520. All the patent claims will be reexamined.

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
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AND TRADEMARK OFFICE
Washington, D.C. 20231

CONTROL NUMBER	ORDER DATE	PATENT NUMBER	PATENTEE
90/006,495	December 26, 2002	6,317,592	Campana et al.

ANTONELLI, TERRY, STOUT AND KRAUS
SUITE 1800
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EXAMINER	
Dwayne Bost	
ART UNIT	PAPER NUMBER
2681	1

DATE MAILED: **December 26, 2002**

DIRECTOR INITIATED ORDER FOR REEXAMINATION

Attachment(s): ☒ PTO-892. ☐ PTO-1449.
☐ Other: ____________

Response Time For Patent Owner's Statement:

TWO MONTHS from the date hereof. 37 CFR 1.530(b).

Notes: If the patent owner does not file a timely statement under 37 CFR 1.530(b), reexamination will proceed in accordance with 37 CFR 1.550(a).

An identification of the claims, the references relied on, and the rationale of the decision to order reexamination is attached.

REEXAMINATION ORDER:

Pursuant to 37 CFR 1.520, reexamination is ordered. Note the attached decision.

Pursuant to 37 CFR §1.520 the Director of the United States Patent and Trademark Office has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-665 of U.S. Patent No 6,317,592.

RELEVANT PRIOR ART

[1] Textbook Computer Structures: Principles and Examples, chapters 5, 24 and 25, by Siewiorek et al., published by McGraw-Hill book Company, copyright 1982.

[2] Heart et al., (Bolt Bernack and Newman, Inc.), "The interface message processor for the ARPA computer network," Spring Joint Computer Conference Proceeding, 1970, pp. 551-567.

[3] S.M.Ornstein et al., (Bolt Bernack and Newman, Inc.), "The Terminal IMP for the ARPA Computer Network," AFIPS Conference Proceedings, June 1972, pp. 243-254.

[4] Cerf, V.G., and Kahn, R.E. "A protocol for packet network intercommunication," IEEE Transactions on Communications, vol. Com-22, May 1974, pp. 637-648.

[5] Binder, R. et al. (Hawaii University Honolulu), "ALOHA Packet Broadcasting – A Retrospect," January 1975, 25 pgs. (contract number: NAS2-8590, ARPA Order-1956).

[6] Binder, R. et al. (University of Hawaii Honolulu, Hawaii), THE ALOHANET MENEHUE – VERSION II, ARPA Order-1956, September 1974, pp. 1-55.

[7] Binder, R. (University of Hawaii) ALOHANET PROTOCOLS, ARPA Order No. 1956., September 1974, pp. 1-36.

[8] Abrahmson, N., "Development of the ALOHANET," IEEE Transactions on Information Theory, Vol. IT-31, No. 2, March 1985, pp. 119-123.

[9] Roberts, L., "Data by the Packet," IEEE Spectrum, Vol. 11, pp. 46-51, February 1974.

[10] Nelson, H.A., "The ARPANET IMP (Interface Message Processor) Port Expander," pp. 1- 48, November 1980.

[11] U.S. Patent 5,159,592 (Perkins), issued Oct. 27, 1992, filed Oct. 29, 1990.

DECISION

The claims of the 592 patent are drawn to a system and method for connecting e-mail systems and hence electronic mail to an RF transmission network and ultimately to a specific RF receiver.

Claim 1 is exemplary:

> In a communication system comprising a wireless system which communication system transmits electronic mail inputted to the communication system from an originating device, mobile processors which execute electronic mail programming to function as a destination of electronic mail, and a destination processor to which the electronic mail is transmitted from the originating device and after reception of the electronic mail by the destination processor, information contained in the electronic mail and an identification of a wireless device in the wireless system are transmitted by the wireless system to the wireless device and from the wireless device to one of the mobile processors connected thereto, the originating device
> comprising:
>
> a programmed processor which executes electronic mail programming to originate the electronic mail, the electronic mail containing an address of the destination processor and the information contained in the electronic mail to be transmitted to the destination processor.

References [1]-[10]

References [1]-[10] describe a system, method and details related to the equipment and protocols used to link computers together to form the ARPA Network (forefather of today's Internet) [1]. The ARPA Network links numerous host computers (read on originating processors w/in an electronic mail system) together. A host may send a message to another specific host (in which the specific host would then be read as a destination processor). The data which is transmitted by an origination host includes information as to the destination. This data is received via an IMP or Interface Message Processor. The IMP or more flexible TIP (an IMP with a flexible terminal handling capability) [2] is the backbone for routing w/in the ARPA Network. [1]. The IMP or TIP would accept the data, split the data into packets, add header information which included the source and destination address for each packet (read on interface addressing) and broadcast the packets to other IMPs within the system for ultimate accumulation and reassembly of each packet in turn in order to retrieve the original data for delivery of the intact data to the destination host processor [2] [3] [4] [9]. Reference [1] provides good pictorial layouts of the ARPA Network-1979, (section 5, Figures 10 and 11, pp. 397-398). As can be seen, there are wired connections coupling the various host/IMPs covering the continental United States (read on originated information originating from one of the originating processors and transmitted with the electronic mail system without using an RF information transmission network).

Depicted in the figures referenced above (and described in references [1] [5] [6] [7] [8]) the ARPA Network was also interfaced with an RF information transmission network, i.e., the ALOHANET, wherein information/electronic message/data, etc. originating from a host (originating) processor within the ARPA Network was deliverable to a host (destination) processor within the ALOHANET via a TIP or IMP (MENEHUE). The MENEHUE or ALOHANET's IMP received information from other IMPs within the ARPA Network (or from within the ALOHANET system for internal delivery or delivery to an IMP and destination host processor within the ARPA Network) and would operate in the same fashion to gather all of the packets together, to recover the original information/data/electronic message, etc. The ALOHANET is read on an RF information transmission network coupling destination processor together as well as to the ARPA Network.

The MENEHUE is read on the at least one addressed interface connecting an electronic mail system to the RF information transmission network in that the manner of transmitting data/information/electronic messages, etc. to the other processors within the ALOHANET system is accomplished via radio packet broadcasting. Information received from a host (originating) processor within the ARPA Network for example, would be received by the ALOHANET, assembled and then packetized with the specific destination processor/receiver address. The information is transmitted via a radio packetized broadcast via the MENEHUE, wherein either a repeater or host (destination) processor terminal unit, with the appropriate address only, would receive and process the transmitted information. [5] [6] [7] [8].

The origination or host processor, within either connected network (ARPA Network or ALOHANET) would add the destination information to the originated information in order for the information to be routed correctly in the first place. The previous paragraph's example of a host processor sending information/data/electronic message etc. to a destination processor in the ALOHANET, reads on the claim limitation whereby the originated information is transmitted from the one interface (IMP connected to the host processor initiating the transmission) to the RF information transmission network with an address for a specific destination processor (i.e., one in which requires a radio packet broadcast in order to reach in the ALOHANET). [5] [6] [7] [8].

Reference [11] (U.S. Patent to Perkins)

The Perkins patent describes an INTERNET based system which allows for packet switch routing of information/data/electronic messages etc. between host processors across the Internet. This process is similar to that described with respect to the ARPA Network above (the ARPA Network was the forefather of Today's Internet). The problem that Perkins addresses has to deal with the connection of mobile communication units to LANs for addressing via packets routed from wired electronic mail systems into the wireless or RF transmission network.

The backbone of the INTERNET includes the host processors, routers, packeting processes as described previously, which reads on the claimed origination and destination processors (destinations not connected via an RF network) and interface routing via packeting processes which includes source and destination addressing. The problem the Perkins foresaw dealt with the addressing of mobile or non-fixed (RF) units. Fixed or wired Internet connection would have a permanently assigned TCP/IP routing address. If an end terminal were mobile, such as suggested by Perkins, then a fixed routing address would not work.

Perkins suggests a system/method for connecting the wired network to mobile users within an RF transmission network, see column 2, lines 4-10, lines 55-65; and column 3, lines 1-15. Column 3, lines 23-26 describe the local gateway as the interface device between the wired network and the RF transmission network with lines 5-8 stating that the routers of the wired Internet are instructed to forward packets destined for the wireless transmission network, to the global gateway. This reads on the addressing of the packets from an origination processor to the interface (global gateway) which connects the electronic mail system (INTERNET) to the RF information transmission network

Perkins goes on to describe that a mobile device may register with a particular LAN (local area network) by transmitting a unique identifier, such as its serial number, that is permanently stored within a memory of the mobile unit 10. The gateway (read as interface to RF transmission network) then associates this mobile ID with a pseudo-IP address which is assigned to the mobile device on a dynamic basis, column 5, lines 57-65. When the global gateway (interface) receives data/information/electronic message for a specific mobile unit (routed via destination address and delivered to the gateway) the gateway matches the received data to a dynamically assigned pseudo-IP address for the mobile and transmits the message to the appropriate LAN which broadcasts to the proper destination mobile (read on destination processor). Inherently the global gateway must have from the incoming packets, information with respect to the destination mobile which is entered from the origination processor, in order to associate the received packetized information/data/electronic message etc. for delivery to a specific mobile unit, see column 4, lines 25-60. Column 7, lines 54-56 and Column 8 lines 33-39 of Perkins provide examples of packet routing from the viewpoint of the mobile unit acting as origination processor. The IP address of the destination (remote user) processor is added to original data being transmitted and wherein the origination processor (mobile unit) adds header information to outgoing data so that the remote user (destination processor) knows that the data was initiated from the specific source, i.e. the mobile device. This example of TCP/IP routing demonstrates the claim limitations of adding address information at an origination processor originating the originated information.

Reexamination Control No. 90/006,495

CONCLUSION

In view of the above patent and printed publications and their teachings, a substantial new question of patentability is raised as to claims 1-665 of U.S. Patent 6,317,592. Reexamination of U.S. Patent 6,317,592 is ordered under 37 CFR § 1.520. All the patent claims will be reexamined.

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,677	06/24/2003	5479472		5442

20457 7590 09/03/2003

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EXAMINER	
L. Kincaid	
ART UNIT	**PAPER NUMBER**
2681	5

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CC: David L. Stewart (third party)

PTO-90C (Rev. 07-01)

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David L. Stewart
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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006677

PATENT NO. 5,479,472

ART UNIT 2681

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

Order Granting / Denying Request For Ex Parte Reexamination	**Control No.** 90/006,677	**Patent Under Reexamination** 5479472	
	Examiner Lester G. Kincaid	**Art Unit** 2685	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 24 June 2003 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

Reexamination

1. A substantial new question of patentability affecting claims 1-62 of United States Patent Number 5,479,472 is raised by the request for reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

Issues Raised in the Request

The Request for Reexamination incorporates a LIST OF APPENDICES and also provides a PTO-1449 form, both of which list pertinent prior art to be considered in the Request. The Request is somewhat confusing in that the LIST OF APPENDICES and the PTO-1449 both refer to listed prior art using different identifiers. For example, reference "B1" on the LIST OF APPENDICES appears to be identical to reference "AD" on the PTO-1449; and reference "B2" on the LIST OF APPENDICES appears to be coincide with reference "AE" on the PTO-1449. Furthermore, some of the 'references' listed in the LIST OF APPENDICES (such as references "B3", "C1" and "D1") are not listed on the PTO-1449, inasmuch as they are claim charts (not prior art) provided by the requester.

Furthermore, the choice of language used to set forth the issues raised in the request are confusing. For example, the Request sets forth that each of the independent claims is "anticipated" by single "reference B1 (GSM/X.400) as explained by references B2 and B4". Yet the "(GSM/X.400)" identifier following reference "B1" implies it must be the combination of at least B1 and B2 together which are to be considered inasmuch as "B1" is the GSM report and "B2" is the X.400 standard.

In an effort to clarify the record, the following paragraphs set forth the examiner's best interpretation of each issue raised in the request. **Furthermore, for consistency, all prior art references have been identified in parentheses by the identifiers they have been provided with the on the PTO-1449, hereafter "1449".**

2. The request indicates that the Requester considers claims 1 and 22 to be unpatentable over each of the following references:

(1) the integration of GSM and X.400 (hereafter GSM/X.400 system) as described in GSM Report 03-42 (1449-AD) entitled "Advanced MHS Access" in combination with references entitled CCITT Standard X.400 (1449 - AE) and "Architectural Aspects of Data and Telematic Services in a GSM PLMN" by Graham Crisp and Alfons Eizenhoefer from the Proceedings of the Third Nordic Seminar on Digital Land Mobile Radio Communications, September 12-15, 1988 in Copenhagen (1449 - AF);

(2) the GSM/X.400 system (as also disclosed by references AD, AE, and AF), but relying on the SMS feature (hereafter GSM/SMS system);

(3) Perkins (1449 - AB);

(4) Zabarsky et al. (1449 - AC);

(5) the printed document entitled "The AlohaNet" (1449 - AG) in combination with Computer Structures: Principles and Examples (1449 - AH), (the combination hereafter The AlohaNet documents);

(6) the combination of the SAM Reference Manual (1449 - AI) and SAM User Manual (1449 - AJ), the combination herefter noted as "TekNow-SAM system";

(7) the combination of references Beginner's Guide to TCP/IP on the Amateur Radio Packet Radio Network Using the KA9Q Internet Software (1449 - AQ) in combination with KA9Q Internet Software Package (1449 - AR), Portable RTTY Operation (1449 - AS), Your Gateway to Packet Radio (1449 - AT), PSR Quarterly -- Sarex II, "Packet Radio from the Shuttle" (1449 - AU), ARRL AMATEUR RADIO 5th Computer Network Conference (1449 - AV), ARRL AMATEUR RADIO 6th Computer Network Conference (1449 - AW), ARRL AMATEUR RADIO 7th Computer Network Conference (1449 - AX), ARRL AMATEUR RADIO 8th Computer Network Conference (1449 - AY), and ARRL AMATEUR RADIO 9th Computer Network Conference (1449 - AZ), the combination hereafter noted as "KA9Q Software",

and claims 2-21 and 23-62 to be unpatentable over each of the above named references individually in conjunction with admissions of prior art in the Campana, Jr. et al patent specification.

3. It is agreed that consideration of the references raises a substantial new question of patentability as to claims 1-62 of the Campana, Jr. et al. patent (5,479,472). As pointed out in the claim charts applying each reference to the recited limitations of the

independent patented claims, the references reasonably convey a system including each of the claimed features. Of the references, only Zabarsky et al. was previously of record in the prosecution of the application that became the Campana, Jr. et al. patent and the requester has detailed a new interpretation of Zabarsky et al. which reasonably provides for the claimed features. Further, there is a substantial likelihood that a reasonable examiner would consider the other teachings, either alone or in combination, as material to the decision of patentability of the Campana, Jr. et al. claims. In addition, as pointed out in the claim charts applying the admitted prior art to the recited limitations of the dependent patented claims, the references in conjunction with the admitted prior art reasonably convey a system including each of the claimed features. Accordingly, the cited references raise a substantial new question of patentability of claims 1-62, which question has not been decided in a previous examination of the Campana, Jr. et al. patent.

4. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,479,472 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Lester Kincaid
Primary Examiner
AU 2685
9/2/07

ALLEN R. MACDONALD
DIRECTOR
TECHNOLOGY CENTER 2600

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

CONTROL NUMBER	ORDER DATE	PATENT NUMBER	PATENTEE
90/006,492	December 26, 2002	5,631,946	Campana et al.

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EXAMINER	
Dwayne Bost	
ART UNIT	PAPER NUMBER
2681	1

DATE MAILED: **December 26, 2002**

DIRECTOR INITIATED ORDER FOR REEXAMINATION

Attachment(s): ☒ PTO-892. ☐ PTO-1449.
☐ Other: ____________________

Response Time For Patent Owner's Statement:

TWO MONTHS from the date hereof. 37 CFR 1.530(b).

Notes: If the patent owner does not file a timely statement under 37 CFR 1.530(b), reexamination will proceed in accordance with 37 CFR 1.550(a).

An identification of the claims, the references relied on, and the rationale of the decision to order reexamination is attached.

REEXAMINATION ORDER:

Pursuant to 37 CFR 1.520, reexamination is ordered. Note the attached decision.

Reexamination Control No. 90/006,492

Pursuant to 37 CFR §1.520 the Director of the United States Patent and Trademark Office has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-185 of U.S. Patent No 5,631,946.

RELEVANT PRIOR ART

[1] Textbook Computer Structures: Principles and Examples, chapters 5, 24 and 25, by Siewiorek et al., published by McGraw-Hill book Company, copyright 1982.

[2] Heart et al., (Bolt Bernack and Newman, Inc.), "The interface message processor for the ARPA computer network," Spring Joint Computer Conference Proceeding, 1970, pp. 551-567.

[3] S.M.Ornstein et al., (Bolt Bernack and Newman, Inc.), "The Terminal IMP for the ARPA Computer Network," AFIPS Conference Proceedings, June 1972, pp. 243-254.

[4] Cerf, V.G., and Kahn, R.E. "A protocol for packet network intercommunication," IEEE Transactions on Communications, vol. Com-22, May 1974, pp. 637-648.

[5] Binder, R. et al. (Hawaii University Honolulu), "ALOHA Packet Broadcasting – A Retrospect," January 1975, 25 pgs. (contract number: NAS2-8590, ARPA Order-1956).

[6] Binder, R. et al. (University of Hawaii Honolulu, Hawaii), THE ALOHANET MENEHUE – VERSION II, ARPA Order-1956, September 1974, pp. 1-55.

[7] Binder, R. (University of Hawaii) ALOHANET PROTOCOLS, ARPA Order No. 1956., September 1974, pp. 1-36.

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[11] U.S. Patent 5,159,592 (Perkins), issued Oct. 27, 1992, filed Oct. 29, 1990.

DECISION

The claims of the 946 patent are drawn to a system and method for connecting e-mail systems and hence electronic mail to an RF transmission network and ultimately to a specific RF receiver.

Claim 1 is exemplary:

> A system for transmitting originated information from one of a plurality of originating processors contained in an electronic mail system to at least one RF receiver with the originated information originating from one of the plurality of originating processors and being transmitted by an RF information transmission network to the at least one RF receiver and for transmitting other originated information originating from one of the originating processors with the electronic mail system without using the RF information transmission network to at least one of a plurality of destination processors comprising:
>
> at least one interface, one of the at least one interface connecting the electronic mail system containing the plurality of originating processors to the RF information transmission network; and wherein
>
> the originated information is transmitted in association with an address of the one interface from the one of the plurality of originating processors to the one interface with the electronic mail system responding to the address of the one interface to direct the originated information from the one of the plurality of originating processors to the one interface; and
>
> the originated information is transmitted from the one of the at least one interface to the RF information transmission network with an address of the at least one RF receiver to receive the originated information being associated with the originated information before transmission of the originated information to the at least one RF receiver.

References [1]-[10]

References [1]-[10] describe a system, method and details related to the equipment and protocols used to link computers together to form the ARPA Network (forefather of today's Internet) [1]. The ARPA Network links numerous host computers (read on originating processors w/in an electronic mail system) together. A host may send a message to another specific host (in which the specific host would then be read as a destination processor). The data which is transmitted by an origination host includes information as to the destination. This data is received via an IMP or Interface Message Processor. The IMP or more flexible TIP (an IMP with a flexible terminal handling capability) [2] is the backbone for routing w/in the ARPA Network. [1]. The IMP or

TIP would accept the data, split the data into packets, add header information which included the source and destination address for each packet (read on interface addressing) and broadcast the packets to other IMPs within the system for ultimate accumulation and reassembly of each packet in turn in order to retrieve the original data for delivery of the intact data to the destination host processor [2] [3] [4] [9]. Reference [1] provides good pictorial layouts of the ARPA Network 1979, (section 5, Figures 10 and 11, pp. 397-398). As can be seen, there are wired connections coupling the various host/IMPs covering the continental United States (read on originated information originating from one of the originating processors and transmitted with the electronic mail system without using an RF information transmission network).

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The origination or host processor, within either connected network (ARPA Network or ALOHANET) would add the destination information to the originated information in order for the information to be routed correctly in the first place. The previous paragraph's example of a host processor sending information/data/electronic message etc. to a destination processor in the ALOHANET, reads on the claim limitation whereby the originated information is transmitted from the one interface (IMP connected to the host processor initiating the transmission) to the RF information transmission network with an address for a specific destination processor (i.e., one in which requires a radio packet broadcast in order to reach in the ALOHANET). [5] [6] [7] [8].

Reference [11] (U.S. Patent to Perkins)

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The backbone of the INTERNET includes the host processors, routers, packeting processes as described previously, which reads on the claimed origination and destination processors (destinations not connected via an RF network) and interface routing via packeting processes which includes source and destination addressing. The problem the Perkins foresaw dealt with the addressing of mobile or non-fixed (RF) units. Fixed or wired Internet connection would have a permanently assigned TCP/IP routing address. If an end terminal were mobile, such as suggested by Perkins, then a fixed routing address would not work.

Perkins suggests a system/method for connecting the wired network to mobile users within an RF transmission network, see column 2, lines 4-10, lines 55-65; and column 3, lines 1-15. Column 3, lines 23-26 describe the local gateway as the interface device between the wired network and the RF transmission network with lines 5-8 stating that the routers of the wired Internet are instructed to forward packets destined for the wireless transmission network, to the global gateway. This reads on the addressing of the packets from an origination processor to the interface (global gateway) which connects the electronic mail system (INTERNET) to the RF information transmission network

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CONCLUSION

In view of the above patent and printed publications and their teachings, a substantial new question of patentability is raised as to claims 1-185 of U.S. Patent 5,631,946. Reexamination of U.S. Patent 5,631,946 is ordered under 37 CFR § 1.520. All the patent claims will be reexamined.

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,675 90/006,533	06/24/2003	5436960		5436

803 7590 02/24/2006

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ART UNIT	**PAPER NUMBER**
3992	

DATE MAILED: 02/24/2006

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3

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,533, 90/006,675

PATENT NO. 5,436,960.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/006,533 90/006,675	Patent Under Reexamination 5436960
	Examiner Scott L. Weaver	Art Unit 3992

-- ***The MAILING DATE of this communication appears on the cover sheet with the correspondence address*** --

a☒ Responsive to the communication(s) filed on *15 February 2006* . b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire *TWO* month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Information Disclosure Statement, PTO-1449.
3. ☐ Interview Summary, PTO-474.
4. ☐ ____.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-89,183-193 and 195-233* are subject to reexamination.

1b. ☐ Claims ____ are not subject to reexamination.

2. ☒ Claims *90-182 and 194* have been canceled in the present reexamination proceeding.

3. ☐ Claims ____ are patentable and/or confirmed.

4. ☒ Claims *1-89, 183-193 and 195-233* are rejected.

5. ☐ Claims ____ are objected to.

6. ☐ The drawings, filed on ____ are acceptable.

7. ☐ The proposed drawing correction, filed on ____ has been (7a)☐ approved (7b)☐ disapproved.

8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some* c)☐ None of the certified copies have

   1☐ been received.

   2☐ not been received.

   3☐ been filed in Application No. ____ .

   4☐ been filed in reexamination Control No. ____.

   5☐ been received by the International Bureau in PCT application No. ____.

   * See the attached detailed Office action for a list of the certified copies not received.

9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

10. ☐ Other: ____

cc: Requester (if third party requester)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,494	12/26/2002	6067451		9468

803 7590 02/21/2006

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/21/2006 (handwritten correction: 22)

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG, LLP
1300 EYE STREET NW
400 EAST TOWER
WASHINGTON, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,494, 90/006,681

PATENT NO. 6067451.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	**Control No.** 90/006,494 90/006,681	**Patent Under Reexamination** 6067451	
	Examiner Roland G. Foster	**Art Unit** 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

a☒ Responsive to the communication(s) filed on *30 January 2006* . b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter.
Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**
If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Information Disclosure Statement, PTO-1449.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-341 and 393-437* are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims *1-341 and 393-437* are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ The drawings, filed on *03 December 1999* are acceptable.
7. ☐ The proposed drawing correction, filed on _____ has been (7a)☐ approved (7b)☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. _____ .
   4☐ been filed in reexamination Control No. _____.
   5☐ been received by the International Bureau in PCT application No. _____.
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: _____

cc: Requester (if third party requester)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95000020 & 90006495	05/29/03	6317592	

EXAMINER	
Charles R. Craver	
ART UNIT	PAPER
3992	

William H. Wright
Sturm & Fix LLP
Midland Building
206 Sixth Avenue
Des Moines IA 50309-4076

DATE MAILED:

02/01/06

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

EXHIBIT
tabbies
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400, East Tower
Washington DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER 95/000020; 90/006495

PATENT NUMBER 6,317,592.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No.	Patent Under Reexamination	
	95/000,020 90/006495	6317592	
	Examiner	Art Unit	
	Charles R. Craver	3992	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address.* --

Responsive to the communication(s) filed by:
Patent Owner on 28 December 2005
Third Party(ies) on 10 January 2006

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892
2. ☒ Information Disclosure Citation, PTO-1449 or PTO/SB/08
3. ☐ _____

PART II. SUMMARY OF ACTION:

1a. ☒ Claims 1-764 are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled.
3. ☐ Claims _____ are confirmed. [Unamended patent claims]
4. ☐ Claims _____ are patentable. [Amended or new claims]
5. ☒ Claims 1-764 are rejected.
6. ☐ Claims _____ are objected to.
7. ☒ The drawings filed on 6 December 1999 ☒ are acceptable ☐ are not acceptable.
8 ☐ The drawing correction request filed on _____ is: ☐ approved. ☐ disapproved.
9 ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has: ☐ been received. ☐ not been received. ☐ been filed in Application/Control No _____
10. ☐ Other _____